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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,963	06/16/1999	NAOKI TAKAOKA	1982-0127P	4777

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EXAMINER

LAROSE, COLIN M

ART UNIT PAPER NUMBER

2623

DATE MAILED: 04/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/333,963

Applicant(s)

TAKAOKA, NAOKI

Examiner

Colin M. LaRose

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings filed on 16 June 1999, are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 1, 3, 11, 13, 16, 18, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,828,461 by Kubo et al. ("Kubo").

Regarding claim 1, Kubo discloses an image processing apparatus having an image reading device (element 32, figure 1) for reading an image recorded on a medium, means to output processed image data (element 34, figure 1), means for performing necessary and special image processing (element 12, figure 1 and figure 4), and an instructing means (elements 22 and 24, figure 1) for instructing the special image processing to be carried out by the special image processing means.

Regarding claim 3, Kubo discloses special image processing means that includes an image structure effects for correcting the overall structure of an image, color reproduction effects for correcting the color tone of the image, and special effects for performing a variety of special processings (figure 4).

Regarding claims 11 and 13, figure 4 of Kubo provides a visual means (element 68) to notify the operator of the special image processings that have been instructed.

Regarding claims 16, 18, and 21, Kubo discloses the use of a monitor (element 30, figure 1) that can display an image in a plurality of display states (elements 86-87, figure 8) and an instruction menu (element 84, figure 8) corresponding to image processings that is made to be valid only when the corresponding image is displayed on the monitor (column 21, lines 29-33). Thus, the image processings activated by the menu buttons must match the display state for any instructions to be considered valid.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-8, 10, 14, 15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo in view of "Radio Buttons" by Apple Computer, Inc ("Apple").

Regarding claims 5-8 and 10, in Kubo's disclosure there are available unsuitable combinations of image processings that are mutually opposite or meaningless, such as both enlarging and shrinking an image (element 73, figure 4).

Kubo does not disclose a method by which the execution of the unsuitable combination of enlarging and shrinking is prohibited.

Apple discloses a GUI selection method by which a user may only select one item from a group at a given time. According to the first paragraph on page 1, "only one button in a group can be in the on state, which is indicated by a dot in the middle of the button; activating a radio button turns off whichever button was previously on in that group." Thus, unsuitable combinations are prohibited by awarding priority to the last instructed command and canceling a previously instructed command.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kubo by Apple in order to prohibit combinations of unsuitable processings since simultaneous execution of reciprocal instructions is inherently futile.

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Regarding claims 14 and 15, see the explanation for claim 11.

Regarding claims 19 and 20, see the explanation for claim 16.

7. Claims 2, 4, 6, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo in view of U.S. Patent 5,023,635 by Nealon.

Regarding claim 2, Kubo discloses an instructing means that gives instructions based on a user's manipulation of a mouse (element 24, figure 1) or a keyboard (element 22, figure 1).

Kubo is silent to a system in which a customer provides, to the instructing means, a recording medium containing order information.

Nealon discloses a method by which a customer presents instructions in accordance with a recording medium, which contains encoded order information. "Customer comments and order instructions are recorded magnetically on the film" (column 7, lines 32-34), and the information is transmitted to an order entry station (column 7, lines 37-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kubo by Nealon since inputting a recording medium containing order information to an instructing means is functionally equivalent to inputting order information by a mouse or a keyboard in that both methods accomplish the task of providing instructions.

Regarding claim 4, see the explanation for claim 3.

Regarding claims 6, see the explanation for claim 5.

Regarding claim 12, see the explanation for claim 11.

Regarding claim 17, see the explanation for claim 16.

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8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubo in view of Nealon as applied to claim 6 above, and further in view of Apple.

Regarding claim 9, see the explanation for claim 5.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


U.S. Patent 5,808,723 by Klees discloses a similar processing system in which a customer places orders with a recorded medium.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colin M. LaRose whose telephone number is (703) 306-3489. The examiner can normally be reached Monday through Thursday from 8:00 to 5:30. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au, can be reached on (703) 308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5397.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Colin M. LaRose
Examiner
Group Art Unit 2623


AMELIA M. AU
SUPERVISORY PATENT EXAMINER
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